

REMARKS

Claims 1-27 are pending. An Office Action mailed August 11, 2006 rejected Claims 1-27, and objected to Claim 25 under 35 U.S.C. § 103(a). In response, Applicant hereby amends Claim 25 to correct the noted informality, i.e. that Claim 25 repeated Claim 24. Claim 25 is now drawn to a search on a relational database. Applicant respectfully traverses the rejection of Claims 1 – 27 in light of the following argument. Applicant hereby respectfully requests reconsideration of the application.

The rejected claims, Claims 1-27 were rejected under 35 U.S.C. §103(a) as unpatentable over Dutta et al. (“Dutta” referring to United States Patent Application 2002/0073075) in further view of Searching Social Networks by Bin Yu and Munindar P. Singh (“Bin”). Applicant asserts that the combination of Dutta and Bin does not teach any of the pending claims.

The American Heritage Dictionary defines the verb filter as “2. To remove by passing through a filter.”

v. fil·tered, fil·ter·ing, fil·ters

v. tr.

1. To pass (a liquid or gas) through a filter.
2. To remove by passing through a filter: *filter out impurities.*
3. *Computer Science.* To use a filter to block access to (a website or Web content).

v. intr.

1. To pass through or as if through a filter: *Light filtered through the blinds.*
2. To come or go gradually and in small groups: *The audience filtered back into the hall.*

[Middle English *filtre*, from Old French, from Medieval Latin *filtrum*, of Germanic origin. See *pel-*⁵ in Indo-European Roots.]

fil' ter·er *n.*

fil' ter·less *adj.*

The American Heritage® Dictionary of the English Language, Fourth Edition
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CUSTOMER NUMBER

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The rejection set forth by the Examiner relies upon Paragraphs 0063 and 0064 of Dutta to assert that Dutta teaches filtering, and yet Dutta asserts that Dutta does not filter but rather augments, to wit:

[0064] In contrast with prior art systems, search summary lines 528-532 indicate the type of search that generated the search hit. In the present invention, a distributed, file-sharing-type search on a peer-to-peer network is accomplished by a server executing the search engine along with a conventional search of an index database. ***The user is thus provided with a search result that has been augmented with additional information.*** As noted previously, rather than relying solely on an index search in a database that has only indexed a minor portion of the entire World Wide Web, the present invention also employs a server-based, peer-to-peer search in conjunction with the index search. ***The results from both search processes are combined so that the user receives an augmented search result with more information than a search result that would be produced by either search process individually.*** In addition, the user has the benefit of receiving search results which are (optimistically) more up-to-date than an indexed search.

Independent Claim 1, relies upon a limitation that the method includes “filtering the data to produce a data subset”; Independent Claim 5 includes a computer program with the limitation, “instructions for filtering the data to produce a data subset;” and Independent Claim 9 includes the limitation “a filtering component for filtering the data to produce a data subset.” Dutta teaches augmenting, meaning adding. Thus, as asserted, the filtering component contained in the referenced limitations is not present in Dutta and it is upon Dutta that the rejection relied. For this reason, Claims 1-17 are allowable over Dutta and Bin.

For Claims 18-27, the rejection relies upon Bin to teach a referral system maintaining a social network. In fact Bin teaches a referral system but not the referral system of the Claims.

For suitable rejection under 103(a), the combination must teach each and every limitation: To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or

references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP § 2143 - § 2143.03 for decisions pertinent to each of these criteria.

The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). See MPEP § 2144 - § 2144.09 for examples of reasoning supporting obviousness rejections.

MPEP 706.02(j).

Bin does not teach "content inclusion based upon designated users" in a manner that includes all of the limitations of the claims. In fact, what Bin teaches at 2 are, at 2.1, "Modeling Expertise and Sociability," at 2.2, "Referral Graphs," at 2.3, "Weighted Referral Graphs," and at 2.4, "Propagating Rewards and Penalties." The rejection does not indicate which of these systems the rejection relies upon for teaching all of the claim limitations. As indicated above, the Examiner bears the burden to provide the suggestion of the combination.

More importantly, there is no motivation for combination of Bin and Dutta. As Dutta sets forth in the Abstract, the motivation for Dutta is expressed, "[r]ather than relying solely on an index search in a database that has only indexed a minor portion of the entire World Wide Web, a server-based, peer-to-peer search is initiated in conjunction with the index search." The purpose of Dutta is to combine results from two distinct methods of searching the Internet, specifically index-based searching and peer-to-peer searching:

Rather than relying solely on an index search in a database that has only indexed a minor portion of the entire World Wide Web, a server-based, peer-to-peer search is initiated in conjunction with the index search. The results from both search processes can be combined so that the user receives an augmented search result with more information than a search result from either process by itself.

[0009]

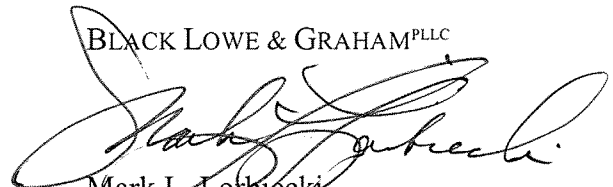
Claim 18 asserts ownership of the limitation of “performing a intersystem search of a database in accordance with the search query.” Intersystem meaning “between two or more systems” is distinct from a search by two distinct means. As such, the current claims are not made obvious by reference to Dutta. Thus Claims 18-27 are also allowable.

CONCLUSION

Applicant respectfully submits that all claims now pending in this patent application are in condition for allowance. Applicant very respectfully requests entry of this amendment and reconsideration and allowance of all claims now pending in this patent application.

Respectfully submitted,

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